

IN THE UNITED STATES PATENT AND TRADEMARK OFFICE

In re PATENT APPLICATION of

MONTGOMERY, Rob R.

Serial No.: 09/963,742

Patent No.: 7,461,024

Filed: September 27, 2001

Confirmation No.: 9308

Examiner: Akintola, Olabode

Group Art Unit: 3691

Customer No.: **26694**
PATENT TRADEMARK OFFICE

For: **Bidder-Side Auction Dynamic Pricing
Agent, System, Method and Computer
Program Product**

PTA PETITION UNDER 37 C.F.R. §1.705(d)

Commissioner for Patents
Mail Stop Petitions
P.O. Box 1450
Alexandria, VA 22313-1450

Dear Madam:

This petition is being submitted in response to the Issue Notification mailed on December 2, 2008, reducing the Patent Term Adjustment (PTA) of the present application from 1342 days to 1222 days. Applicant respectfully petitions the Commissioner for reconsideration of the PTA under 37 C.F.R. §1.705(d) and submits that the correct PTA is 1342 days.

Please charge our deposit account number 22-0261 for the \$200 petition fee. It is not believed that any further fees are due, but in the event that such fees are necessary, the Office is authorized to charge our deposit account number 22-0261.

Statement of Facts:

The relevant facts of the application are as follows:

The application was filed at the United States Patent and Trademark Office (USPTO) on September 27, 2001.

On February 1, 2007 Applicant amended the title from “*Buyer-Side Auction Dynamic Pricing Agent, System, Method and Computer Program Product*” to “*Bidder-Side Auction Dynamic Pricing Agent, System, Method and Computer Program Product*” on page 2 of a Response to Restriction Requirement.

In October of 2007, Applicant noticed that the title had not been corrected and, on October 12, 2007, filed a Supplemental Application Data Sheet to correct, for the second time, the title of the invention.

Later-received Electronic Filing Receipts, dated January 18, 2008 and February 19, 2008, continued to include the incorrect title.

The Notice of Allowance, dated May 9, 2008, which asserted a PTA of 1342 days, again included the incorrect title.

In response to the Notice of Allowance, on August 4, 2008, Applicant filed a Request to Correct Title within the proscribed three-month response period to, for the third time, correct the title.

On December 2, 2008, Applicant received an Issue Notification wherein 120 days had been deducted from PTA recorded in the Notice of Allowance due to the filing of the Request to Correct Title on August 4, 2008.

Request for Reconsideration:

The Applicant respectfully requests reconsideration of the PTA for at least three reasons. First, Applicant is in compliance with 37 C.F.R. §1.705(d). Specifically, this request is being filed within two months of the patent's issuance and raises issues that could not have been raised in response to the Notice of Allowance (as the PTA calculation error occurred after the issue fee was paid).

Second, the Issue Notification has incorrectly counted the number of days between the Notice of Allowance dated May 9, 2008 and the filing of the Request to Correct Title on August 4, 2008. Whereas Issue Notification has determined the number of days to be 120, it is actually only 87 days.

Third, 37 C.F.R. §1.704(c)(10), which allows for a reduction of the patent term when a paper is submitted after the Notice of Allowance, does not apply to this patent. Under §1.705(d) and §1.704, Applicant should not be penalized for filing a Request to Correct Title when Applicant clearly engaged in reasonable efforts to conclude processing or examination of the application. In the instant application, Applicant had clearly raised the issue by having previously tried *twice* to correct the title by Amendment on February 1, 2007 and in a Supplemental Application Data Sheet filed on October 12, 2007. Although, Applicant did receive two Electronic Filing Receipts on January 18, 2008 and February 19, 2008 with incorrect titles, it was not unreasonable for Applicant to have believed that the title was in the process of being corrected by the USPTO and/or that the USPTO E-Filing System had not been updated. Further, Applicant never received a communication directly addressing their requested title change and the Supplemental Application Data Sheet had

only been filed approximately three months prior to the receipt of the first incorrect Electronic Filing Receipt. The Notice of Allowance on May 9, 2008 was the first reasonable indication that the Patent Office had failed to correct the invention title despite Applicant's two previous requests. Thus, Applicant was left with no choice but to file a Request to Correct Title, within the three-month response period, to correct this series of USPTO errors relating to the correction of title.

Furthermore, Applicant engaged in reasonable efforts to conclude prosecution of the application throughout the entire examination process. Applicant filed all responses within the six-month statutory period for response. Applicant did not suspend action, defer issuance, or abandon the application. Applicant did not convert a provisional application to a non-provisional application. Applicant did not submit a preliminary amendment less than one month before the mailing of an Office action. Applicant did not submit a reply having an omission or submit a supplemental amendment after a reply. Applicant did not submit an amendment after the Notice of Allowance had been mailed. Thus, Applicant clearly used reasonable efforts under §1.704.

In conclusion, Applicant is entitled to the entire 1342 days of patent term adjustment because 1) Applicant is in compliance with 37 C.F.R. §1.705; 2) the Examiner incorrectly counted the number of days between the Notice of Allowance and the filing of the Request to Correct Title as 120 days, not 87 days; and 3) Applicant did not fail to take reasonable efforts to conclude the processing or examination of the application as set forth in 37 C.F.R. §1.704. Applicant respectfully requests that the Commissioner reconsider the Examiner's determination of PTA and restore the 120 days that were deducted from the

original determination of 1342 days. A copy of the Patent Term Adjustment History is attached.

Respectfully Submitted,

Dated: January 30, 2009

By: 

Ralph F. Albrecht
Registration No. 43,466
Kyle D. Petaja
Registration No. 60,309
Venable LLP
P.O. Box 34385
Washington, D.C. 20043-9998
Tel.: (202)-344-4000
Telefax: (202)-344-8300

DOC#1009609

09/963,742

Bidder-side auction dynamic pricing agent, system, method and computer program product

01-21-
2009::12:20:01**Patent Term Adjustments**

Patent Term Adjustment (PTA) for Application Number: 09/963,742

Filing or 371(c) Date:	09-27-2001	USPTO Delay (PTO) Delay (days):	1435
Issue Date of Patent:	12-02-2008	Three Years:	-
Pre-Issue Petitions (days):	+0	Applicant Delay (APPL) Delay (days):	213
Post-Issue Petitions (days):	+0	Total PTA (days):	1222
USPTO Adjustment(days):	+0	Explanation Of Calculations	

Patent Term Adjustment History

Date	Contents Description	PTO(Days)	APPL(Days)
11-12-2008	PTA 36 Months		
12-02-2008	Patent Issue Date Used in PTA Calculation		
11-06-2008	Dispatch to FDC		
11-06-2008	Application Is Considered Ready for Issue		
11-07-2008	Filing Receipt - Corrected		
11-06-2008	TC Return to Pubs		
11-06-2008	Pubs Case Remand to TC		
11-06-2008	Response to Amendment under Rule 312		
08-04-2008	Amendment after Notice of Allowance (Rule 312)		120
08-04-2008	Issue Fee Payment Verified		↑
08-04-2008	Issue Fee Payment Received		↑
05-09-2008	Mail Notice of Allowance		↑
05-08-2008	Examiner's Amendment Communication		↑
05-08-2008	Document Verification		↑
05-08-2008	Notice of Allowance Data Verification Completed		↑
03-14-2008	Date Forwarded to Examiner		↑
02-19-2008	Request for Continued Examination (RCE)		32
03-14-2008	DISPOSAL FOR A RCE/CPA/129 (express abandonment if CPA)		↑
02-19-2008	Request for Extension of Time - Granted		↑
02-19-2008	Workflow - Request for RCE - Begin		↑
02-06-2008	Mail Advisory Action (PTOL - 303)		↑
02-04-2008	Advisory Action (PTOL-303)		↑
01-24-2008	Date Forwarded to Examiner		↑
01-18-2008	Amendment after Final Rejection		↑
10-18-2007	Mail Final Rejection (PTOL - 326)		↑
10-18-2007	Final Rejection		
10-12-2007	Miscellaneous Incoming Letter		
10-01-2007	Information Disclosure Statement considered		
10-05-2007	Date Forwarded to Examiner		
10-01-2007	Response after Non-Final Action		61

10-01-2007	Request for Extension of Time - Granted		↑
10-01-2007	Information Disclosure Statement (IDS) Filed		↑
10-01-2007	Reference capture on IDS		↑
05-01-2007	Mail Non-Final Rejection		↑
04-28-2007	Non-Final Rejection		
04-27-2006	Information Disclosure Statement considered		
02-28-2007	Date Forwarded to Examiner		
02-01-2007	Response to Election / Restriction Filed		
02-01-2007	Request for Extension of Time - Granted		
11-01-2006	Mail Restriction Requirement	1435	
10-30-2006	Requirement for Restriction / Election		↑
10-24-2006	Case Docketed to Examiner in GAU		↑
07-18-2006	Case Docketed to Examiner in GAU		↑
04-27-2006	Reference capture on IDS		↑
04-27-2006	Information Disclosure Statement (IDS) Filed		↑
04-27-2006	Information Disclosure Statement (IDS) Filed		↑
05-07-2004	IFW TSS Processing by Tech Center Complete		↑
04-23-2002	Case Docketed to Examiner in GAU		↑
02-04-2002	Case Docketed to Examiner in GAU		↑
12-18-2001	Application Dispatched from OIPE		↑
12-17-2001	Application Is Now Complete		↑
10-23-2001	Notice Mailed--Application Incomplete--Filing Date Assigned		↑
10-23-2001	Correspondence Address Change		↑
10-02-2001	IFW Scan & PACR Auto Security Review		↑
09-27-2001	Initial Exam Team nn		↑

Close Window